

### **Remarks**

Claims 1-60 are pending in the Application, of which Claims 1-3 and 15-16 are being examined, as Claims 4-14 and 17-60 were subject to a restriction and/or election requirement. The Office Action requests the identification, in U.S. Provisional Application No.60/208,521, where the features of the present invention are disclosed. The Office Action objects to the drawings and Claims 1 and 2. Claim 1 and those claims dependent thereon are rejected under 35 U.S.C. §101. Claim 1 is rejected under 35 U.S.C. §102(e). Claims 2, 3, and 15-16 are rejected under 35 U.S.C. §103. In view of the following remarks, reconsideration and withdrawal of the rejection is respectfully requested.

### **Priority**

The Office Action requests that the Applicants identify in the prior application (Provisional Application 60/208,251) where the features of the present invention are first disclosed. In addition, the Office Action requests that the Applicants identify which inventor(s) contributed which features claimed in the present application that were also present in the prior application. The Office Action further alleges that several portions of the disclosure are limited to a filing date of December 13, 2000 including, for example, Figs. 11-27 and related text, Fig. 4, items 48-49, and Fig. 5, item 58.

Based on this indication, the Applicants believe that the Examiner has taken the position that the provisional application does not describe the subject matter of the nonprovisional application in a manner that is sufficient to comply with the written description requirement. The Applicants respectfully submit that the written description requirement of 35 U.S.C. § 112 ¶ 1 does not require that the language of the nonprovisional claims be literally set forth in the provisional priority document. The Federal Circuit has explained that the test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Company v. Far-Mar-Co., Inc.*, 227 USPQ 177, 179 (Fed. Cir. 1985) (citing *In re Kaslow*, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

The Applicants have set forth below a chart indicating at least one portion (some or all of the features may find support in more than one place) of the provisional application that supports the featured claim elements in Claims 1-3 and 15-16 and/or Figures 4, 5 and 11-27:

<b>Listing of Original Claims in U.S. Application No. 09/736,471 filed 12/13/00</b>	<b>Evidence of Support in U.S. Provisional Application No.60/208,521 filed 06/01/00</b>
1. A method for selling a product online, comprising: registering a plurality of retailers; receiving a product order from a user; determining a geographic location of the user; and transmitting the product order to one of the plurality of retailers, based on the geographic location of the user.	Page 2, lines 7-8  Page 4, lines 3-5 Page 3, line 8 Page 2, lines 13-19
2. The method of claim 1, wherein the product corresponds to a purchase of a diamond.	Page 2, lines 10-12 and page 12, lines 13-14
3. The method of claim 1, wherein said registering is performed online.	Page 4, lines 3-5
15. The method of claim 1, wherein said determining comprises: receiving a description of the user's geographic location from the user.	Page 2, lines 13-17
16. The method of claim 15, wherein the description comprises at least one of: a zip code corresponding to the user, a city corresponding to the user and a telephone area code corresponding to the user.	Page 2, lines 13-17 and page 13, lines 16-21
Figure 4, items 48-49	Figures 4 and 5; Page 4, line 12-Page 5, line 3
Figure 5, item 58	Figure 5; Page 5, lines 12-16; Page 12, lines 3-12
Figure 11	Page 11, lines 4-14
Figure 12	An exemplary seller's homepage
Figure 13	Figure 7; Page 2, lines 13-22; Page 13, lines 11-21
Figure 14	Figure 9; Page 3, lines 1-7; Page 12, lines 13-19
Figure 15	Figure 9; Page 12 lines 3-19; Page 14, lines 17-22
Figure 16	Figure 9; Page 3, line 19-Page 4, line 2
Figure 17	Page 15, lines 10-16

Figures 18-21	Figure 9; Page 3, line 19-Page 4, line 2; Page 16, line 21-Page 17, line 2
Figure 22	Page 3, lines 8-13
Figure 23	Page 3, lines 1-7; Page 15, lines 10-16
Figure 24	Page 3, lines 1-7
Figure 25	Figure 5; Page 12, lines 3-12
Figure 26	Page 4, lines 20-23
Figure 27	Page 12, line 20 – Page 13, line 10; Page 17, lines 9-20

In addition, Applicants note that Mr. Rothman contributed to the features set forth in Claims 1-3 and both Messrs. Rothman and Arazi contributed to the features set forth in Claims 15 and 16.

### **Objections to the Drawings**

The Office Action objects to the drawings alleging that Fig. 11, reference 1106 should read “get earliest known router location” to match the description on page 24, lines 2-4.

Applicants have included herewith a replacement page of Figure 11 in accordance with the present specification on page 24, lines 2-4 as well as Claims 17, 36, 37, 39, 40 and 41. Thus, Applicants have obviated the objection to Figure 11, and therefore, Applicants respectfully request that the objection be reconsidered and withdrawn.

### **Objections to the Claims**

The Office Action objects to Claim 1 because it refers to retailers, which appear to be synonymous with distributors, as per page 7, line 22 through page 8, line 8.

Applicants respectfully direct the Examiner to page 7, lines 22-23 of the present specification, which sets forth the phrase “a plurality of local retailers (also referred to herein as distributors)”. Thus, Applicants believe that use of the terms “retailer” and “distributor,” as well as any derivations thereof, are interchangeable, and therefore Applicants respectfully request that the objection be reconsidered and withdrawn.

The Office Action also objects to Claim 2 because it reads "...a product may correspond to a purchase of a diamond." The Office Action indicates that Claim 2 will be interpreted as "...a product may be diamond".

Applicants have amended Claim 2 so that it now recites "...the product is a diamond" and respectfully request that Claim 2 be interpreted accordingly. Thus Applicants have obviated the objection, and therefore, respectfully request that the objection be reconsidered and withdrawn.

#### **Claim Rejections Under 35 U.S.C. §101**

Claim 1 and the claims dependent thereon stand as rejected under 35 U.S.C. §101 alleging that the claim invention is directed to non-statutory subject matter. The Office Action indicates that for a claimed invention to be statutory, it must be within the technological arts and alleges that in the present case, the only allusion to technology appears in the use of the word "online" in the preamble. Moreover, the Office Action alleges that the steps of Claim 1 do not breathe life into the preamble since each of the steps can be performed without the use of technology and that the use of "...transmitting..." does not cure this fact, since to transmit is to send or convey from person or place to another, as might be done with a human messenger.

Applicants have amended Claim 1, inserting the term "computer-implemented" in the preamble. Throughout the Application, ample support is provided to indicate the subject matter of Claims 1-3 and 15-16 may be computer-implemented. As a result, Applicants respectfully request that the rejection be reconsidered and withdrawn.

#### **Claim Rejections Under 35 U.S.C. §102**

Claim 1 is rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,336,100 (Yamada).

In order to sustain an anticipation rejection, each and every limitation of a particular claim must be either expressly or inherently described in a single prior art reference. (See MPEP 2131). Yamada does not teach, or even suggest, each and every limitation of Claim 1. Yamada discloses an online shopping system in which a customer can designate addresses or places where the goods are to be delivered. (See Yamada at column 1, lines 19-22). In the system disclosed by Yamada,

customers are required to sign up or register for entering the online shopping system thereby allowing the customer to purchase goods online. (See Yamada at column 2, lines 57-65 and Claims 1, 2, 9 and 11). As a result, Yamada does not teach or suggest each and every limitation of Claim 1 of the present patent application.

In sharp contrast to Yamada, the method of Claim 1 provides for the selling, promoting and distribution of a product online, but does not require that the user register in order to enter the online shopping system or require that the user's purchase occur online in order to take advantage of its shopping capabilities. Moreover, according to the method of Claim 1 a user may effectuate the purchase of a product either online or offline. The Applicants' specification at page 7, lines 5-15, as well as newly amended Claim 1, both indicate that a user may order a product online through a website, where the user can specify whether it will be an online or an offline purchase. Upon receipt of an online purchase order, the network server can communicate with a third party payment processing server and the operator of the network can then ship the product to the user at an address specified by the user. However, upon receipt of an offline purchase request, the user can be directed to one or more retailers selling the product in the same geographic location as the user. The user can then pick up the product at the local distributors location, and can further pay for the product at that location. Yamada does not teach or suggest the capability of purchasing a product online or offline in conjunction with a method for selling a product online. Thus, Yamada cannot anticipate Claim 1 and therefore, Applicants respectfully request that the rejection be reconsidered and withdrawn.

Moreover, Yamada does not provide for the direct shipment of goods from a distributor/retailer to a customer. Instead, Yamada teaches away from Claim 1 by disclosing the use of multiple "home deliverers" to ship goods to customers, where in response to receiving order information the manufacturer or wholesaler delivers the good or commodity to the retailer. The retailer, in turn, passes the commodity to a first home deliverer. The first home deliverer then passes the commodity on to a second home deliverer that is closest to the place of residence of the customer. The second home deliverer then checks the delivery information and delivers the commodity to the place where the commodity should be delivered. (See Yamada at column 3, lines 26-54 and Figure 1).

In sharp contrast to Yamada, the method of Claim 1 does not require the use of multiple home deliverers. Instead, the method of Claim 1 transmits the product order to one of a plurality of retailers, based on the geographic location of the user. Thus, a local retailer/distributor acts on the product order and ships the product directly to the consumer, or alternatively, the consumer can go directly to the retailer/distributor to pick up the product. (See Applicants' specification at page 20, line 13 through page 21, line 11). As a result, the method of Claim 1 involves fewer steps thereby lending itself to greater efficiency while allowing for fewer instances where mistakes in delivery could occur. Therefore, since Yamada teaches away from the method of Claim 1 it cannot anticipate Claim 1, and thus the Applicants respectfully request that the rejection be reconsidered and withdrawn.

#### **Claim Rejections Under 35 U.S.C. §103**

Claim 2 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,336,100 (Yamada) in view of U.S. Patent No. 5,950,178 (Borgato).

As set forth above, Yamada does not suggest Claim 1 (from which Claim 2 depends), and in fact, teaches away from Claim 1 in that the system disclosed by Yamada requires customers to sign up or register for entering the online shopping system thereby allowing the customer to purchase goods online (See Yamada at column 2, lines 57-65 and Claims 1, 2, 9 and 11) as well as not providing for the direct shipment of goods from a distributor/retailer to a customer. Applicants also thank the Examiner for acknowledging that Yamada does not disclose that a product may correspond to a purchase of a diamond. As a result, the Office Action relies on Borgato to cure this deficiency.

Borgato is directed to the sale of gems, namely diamonds, as is evidenced in the specification at column 2, lines 16-34; column 5, lines 10-15; and claims 1, 10, 16 and 18 (all independent claims) and does not disclose that products other than gems may be sold online using the system described therein. Moreover, Borgato discloses and requires the inclusion of limitations such as, for example, data relating to each stone being offered for sale, a means for forming a data matrix array, a means for price comparison and a means for a buyer to communicate a bid for particular stones. Thus, Borgato is very narrow in its focus and fundamentally different from the subject matter of Claim 2. Thus, one of skill in the art would not combine Yamada and Borgato to result in the subject matter of

Claim 2, because while Borgato does make reference to the sale of diamonds, there is no proper suggestion or motivation in Borgato to cure the deficiencies of Yamada as set forth above.

Moreover, even if one skilled in the art were to combine Yamada with Borgato as suggested by the Office Action, the combination would fail to provide the subject matter according to Claim 2, where a user may effectuate the purchase of a product such as a diamond either online or offline (See Applicants' specification on page 7, lines 5-15), while delivery of the product does not require the use of multiple home deliverers. As a result, the cited references do not render obvious the subject matter according to Claim 2, and the Applicants respectfully request that the rejection be reconsidered and withdrawn.

Claims 3 and 15-16 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,336,100 (Yamada) in view of U.S. Patent No. 6,629,135 (Ross, Jr. et al.).

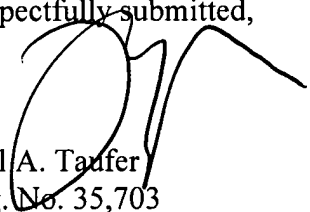
As set forth above, Yamada does not suggest Claim 1 (from which Claims 3 and 15-16 depend), and in fact, teaches away from Claim 1 in that the system disclosed by Yamada requires customers to sign up or register for entering the online shopping system thereby allowing the customer to purchase goods online (See Yamada at column 2, lines 57-65 and Claims 1, 2, 9 and 11) as well as not providing for the direct shipment of goods from a distributor/retailer to a customer. Applicants also thank the Examiner for acknowledging that Yamada does not disclose online registration. As a result, the Office Action relies on Ross, Jr. et al. to cure this deficiency.

Ross Jr. et al. act as an e-commerce outsourcing system rather than acting as a method of sale from a retailer/distributor. In Ross, Jr. et al. the system provides the look and feel of a participating Host where links to particular products or product categories may be present. The look and feel of a Host is captured and stored by receiving an identification of an example page of a target host. In essence, the pages give the viewer the impression that they are viewing the pages served by the host (See Ross, Jr. et al. at column 3, lines 6-31; and claims 1, ). However, the viewer is actually viewing an outsourced copy of the host page. Thus, the viewer is not dealing directly with the retailer/distributor, which is a fundamental difference from Claims 3 and 15-16 of the present invention. Thus, one of skill in the art would not combine Yamada with Ross, Jr. et al. because there is no proper suggestion or motivation to deal directly with the retailer/distributor or to cure the deficiencies of Yamada as set forth above.

Moreover, even if one skilled in the art were to combine Yamada with Ross, Jr. et al. as suggested by the Office Action, the combination would fail to provide the subject matter according to Claims 3 and 15-16, where a user may deal directly with a distributor/retailer, effectuate the purchase of a product such as a diamond either online or offline. ( See Applicants' specification on page 7, lines 5-15), while delivery of the product does not require the use of multiple home deliverers. As a result, the cited references do not render obvious the subject matter according to Claims 3 and 15-16, and the Applicants respectfully request that the rejection be reconsidered and withdrawn.

It is respectfully submitted that the entire application is now in condition for allowance, which action is earnestly solicited. If the Examiner believes that any further minor amendments or corrections as to matters of form would expedite the allowance, the Examiner is invited to telephone the Applicants' undersigned representative.

Respectfully submitted,



Paul A. Taufer  
Reg. No. 35,703  
Attorney for Applicants

PAT:nn  
(215) 656-3385